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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/996,398

11/28/2001

Jai K. Back

212/340

3095

21611

7590

09/29/2006

SNELL & WILMER LLP
600 ANTON BOULEVARD
SUITE 1400
COSTA MESA, CA 92626

EXAMINER

STASHICK, ANTHONY D

ART UNIT

PAPER NUMBER

3728

DATE MAILED: 09/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/996.398

Applicant(s)

BAEK, JAI K.

Examiner

Anthony Stashick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-16 and 18-28 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9-16 and 18-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-7, 9-16 and 18-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Porcher 4,702,022 in view of Dalvy et al. 5,924,218, Mashita et al. 5,681,649, Finn 3,410,004 and Farrior 6,691,431. Porcher discloses all the limitations substantially as claimed including the following: a liner with multiple resilient layers (see Figure 3A especially, showing an inner liner, a resilient layer on top of the inner liner; a second resilient layer on top of the first resilient layer, and at least an outer cover layer, all shown in the heel and forefoot areas). All the layers of the liner boot, including the vacuum layer, are provided to make the boot more comfortable on the user's foot and to protect the user's foot during use. Porcher further discloses a vamp located rearwardly of the toe box. Porcher does not disclose a gel pad located between any of the layers in the toe box area or the heel area or the gel layers tapering at the edges and thickest in the middle. Dalvy et al. '218 teaches that a gel pad 5 can be located between the layers of an inner boot (especially in the heel area as shown in Figure 1) to aid in protecting the user's foot and to help in cushioning the user's foot and fitting the boot to the user's foot. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, in view of Dalvy et al. '218, to place a gel pad in the heel area of the liner of Porcher '022 to aid in protection and comforting the user's foot within the boot. Mashita et al. '649 teaches that a gel pad, made of styrene and butadiene, can be located in many areas of footwear including the toe box area, to aid in cushioning and protecting the user's foot. Therefore, it would have been obvious to place a gel pad in the toe box area of Porcher '022, as taught by Mashita et al. '649, between any of the layers of the toe box to aid in cushioning, protecting

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and comforting the user's foot within the boot. Finn '004 further supports Mashita et al. '649 by showing that resilient pads 14 can be located in the toe and heel areas of a shoe to aid in fitting the inner lining to the shape of the user's foot. Farrior '431 teaches that a gel pad located within footwear can gradually taper in a direction outwardly from the center, thereby making the center of the pad the thickest area of the pad. The taper occurs both front-to-back as well as side-to-side. The tapering thickness provides the appearance of curvature to the top of the foot and pronounces the arch (see Farrior, co. 5, lines 38-44). Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to taper the gel pads of the references as applied above to better fit the pad in the area desired while making the transition from the pad to the remainder of shoe more smooth so that a seam is not felt by the user during use. With respect to the different Shore A hardnesses of the toe box and heel counter, it appears that it would have been a mere matter of testing and optimization to find a combination of material that would provide the desired comfort and protection that would meet the desired total hardness of different areas of the boot.

Response to Arguments

3. Applicant's arguments filed July 19, 2006 have been fully considered but they are not persuasive. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the references teach the desirability of comfort and fit that is one of the same goals of the other references, thereby meeting reasons/suggestion to combine when taken as a whole with the other references before one. With respect to the applicant's argument that no

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reason to combine has been established between Farrior (a dance shoe) and a ski boot, this argument is also not persuasive. Clearly the teaching of tapering a pad within a piece of footwear so that the user does not feel the transition of the pad would apply to any footwear where comfort and fit are desired, as noted in the rejection set forth above. With respect to applicant's argument that the combination of the references is not within the knowledge of one of ordinary skill in the art, this argument is also not persuasive. It appears that applicant is limiting the skill of one of ordinary skill in the art to that of boot or ski boots rather than one of ordinary skill in the art of footwear. One of ordinary skill in the art of footwear would recognize the desire of fitting a piece of footwear to feel comfortable on the user's foot no matter what the intended use of the footwear would be. Applicant's arguments that Farrior teaches only augmenting the user's foot are not persuasive. Farrior teaches that without tapering, the pad would appear bulky and have a bubble effect. This would affect both the outward view as well as that portion facing the foot, thereby making the foot uncomfortable because the transition between the shoe and the pad would be felt by the user. Farrior solves this problem by tapering the pad so that the shoe doesn't look bulky and the user doesn't feel the transition between the shoe area without the pad and that area with the pad.

Conclusion

4. Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111, including: "The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. A general allegation that the claims "define a patentable invention" without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section. Moreover, "The prompt development of a clear Issue requires that the replies of the applicant meet the objections to and rejections of the claims." Applicant should also

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specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06 II(A), MPEP 2163.06 and MPEP 714.02. The "disclosure" includes the claims, the specification and the drawings.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Stashick whose telephone number is 571-272-4561. The examiner can normally be reached on Monday-Thursday 8:30 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'Anthony Stashick', is positioned above the printed name.

Anthony Stashick
Primary Examiner
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ADS